

### **REMARKS**

Applicants note with appreciation the confirmation that Claims 9 and 10 have been allowed and that Claims 2 and 5-8 would be allowable if rewritten in independent form. The Official Action objected to dependent Claims 11 and 13-15 as being of improper dependent form for being duplicates of Claims 2 and 4-6, respectively. The Official Action also rejected Claims 1, 3, 4 and 11-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,580,616 to Joseph Merkwacz.

When dependent Claims 11-15 were newly presented in the prior Amendment dated August 2, 2004, new dependent Claims 11-15 were drafted in error to depend upon independent Claim 1, as opposed to new independent Claim 9. As now amended, dependent Claims 11-15 properly depend from independent Claim 9 so as to no longer be duplicates of similar dependent claims that depend from independent Claim 1 and so as to be patentably distinct from the Merkwacz '616 patent for at least the same reasons as independent Claim 9, which was previously allowed. Thus, the objection to Claims 11 and 13-15 as being of improper dependent form and the rejection of Claims 11-15 under 35 U.S.C. §103(a) are therefore overcome. Moreover, Applicants submit that the amendment of dependent Claims 11-15 so as to now depend from independent Claim 9, as opposed to independent Claim 1 does not raise new issues and should be substantively considered and entered at this state of prosecution since the amendment of dependent Claims 11-15 to depend from independent Claim 9 merely provide further recitations relating to the sleeve of independent Claim 9, which has already been allowed. With respect to independent Claim 1, as well as dependent Claims 3 and 4, the rejection under 35 U.S.C. §103(a) is traversed, since the Merkwacz '616 patent does not teach or suggest the sleeve of independent Claim 1. In light of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration of the present application and allowance of the pending claims.

The sleeve of independent Claim 1 includes a core having an inner surface and an outer surface, a first layer bonded to the inner surface of the core and a second layer bonded to the outer surface of the core. As further recited by independent Claim 1, the second layer is a material having a lower coefficient of friction than the first layer. By designing the sleeve such

that the second layer has a lower coefficient of friction than the first layer, the sleeve may be more readily installed upon the end portion of a pair of adjacent conduits by facilitating the sliding of a retaining ring over the sleeve.

The Merkwacz '616 patent describes an arch-type expansion joint having a central, annular expansion arch 10, connected by cylindrical portions 12 to radially extending connection flanges 14. The connection flanges 14 are connected by bolts 16 to corresponding connection flanges of pipes 20. As described in column 1, lines 48-52, the expansion joint consists of a plurality of plies 22 of rubber-impregnated fabric material. The plurality of plies are divided into inner plies 22a and outer plies 22b. The reinforcing joint includes a reinforcing means between the inner and outer plies consisting of a plurality of coils of glass fiber cord 24 imbedded in a rubber mass 26. The reinforcing means are organized into two glass fiber cord portions; one on each side of the central expansion arch. The expansion joint may optionally include interior layers or plies 28 of flexible rubber disposed within and integral with the rubber mass and extending between the two separate glass fiber cord portions. Finally, the interior surface of the expansion joint may include a homogenous impervious lining 30 designed to protect the other portions of the expansion joint from corrosive fluids carried through the joint, as well as an outer skin or coat 32 of rubber to protect the underlying fabric and to give the joint a smooth exterior surface.

The Official Action contends that the rubber mass 26 in which the glass fiber cords 24 are disposed constitutes a core of a sleeve having inner and outer surfaces with the optional interior layers or plies 28 of flexible rubber constituting a first layer bonded to the inner surface of the core and the outer plies 22b constituting a second layer bonded to the outer surface of the core and extending lengthwise beyond the core. The Official Action notes, however, that "Merkwacz does not specifically disclose that the second layer is made from a material having a lower coefficient of friction than the first layer." The Official Action contends that it would be obvious to design the second layer, that is, the outer plies 22b, to have a lower coefficient of friction than the first layer "because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art", citing *In Re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

The Merkwacz '616 patent describes the outer plies 22b to be comprised of a "suitable, strong, rubber-impregnated fabric material". See column 1, lines 49-50 of the Merkwacz '616 patent. Similarly, the Merkwacz '616 patent describes the interior layers or plies 28 (considered by the Official Action to be the first layer) to be formed of flexible rubber. Thus, as noted by the Official Action, nowhere does the Merkwacz '616 patent teach or suggest that the outer plies and the interior layers or plies should be formed of materials having a different coefficient of friction. While the relative coefficients of friction are not addressed by the Merkwacz '616 patent, the present application describes the second layer to be formed of a material having a lower coefficient of friction than the first layer to permit the retaining ring 16 to be slid over the sleeve without difficulty. See page 11, lines 18-21 of the present application. In contrast, the outer plies 22b, which are considered by the Official Action to be akin to the second layer of the claimed invention, are not the outermost layer since an outer skin or coat 32 is described to overlie the outer plies 22b. As such, there would be no motivation or suggestion to fabricate the outer plies of a material having a lower coefficient than the first layer since the coefficient of friction of the outer plies 22b would seem to be immaterial in terms of the functionality of the expansion joint of the Merkwacz '616 patent. In this vein, the coefficient of friction of any of the layers of the expansion joint of the Merkwacz '616 patent, including the outer plies 22b, would appear immaterial since nothing is slid on or over the expansion joint of the Merkwacz '616 patent and, instead, the connection flanges 14 are connected by bolts 16 to connection flanges 18 of pipes 20. Thus, Applicants submit that neither the intended use of the expansion joint of the Merkwacz '616 patent nor any other design consideration would motivate or suggest one skilled in the art to fabricate the outer plies 22b of a material having a lower coefficient of friction than the interior layers or plies 28 and, as such, the selection of such a material as per the claimed invention is not properly taught or suggested by the Merkwacz '616 patent.

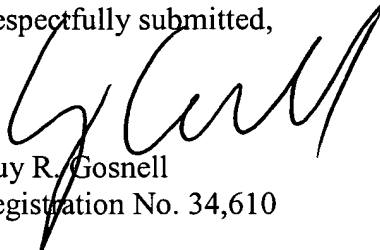
Accordingly, Applicants submit that independent Claim 1, as well as the claims that depend therefrom, are not taught or suggested by the Merkwacz '616 patent. Thus, rejection of Claims 1, 3 and 4 as being obvious over the Merkwacz '616 patent, is therefore overcome.

### **CONCLUSIONS**

In view of the amendments and the remarks presented above, it is respectfully submitted that all of the present claims of the patent application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

  
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